

REMARKS

Accompanying Information Disclosure Statement

This Amendment is being co-filed with an Information Disclosure Statement that includes an office action and cited references from co-pending Application Serial No. 10/638,145. Application Serial No. 10/638,145 itself is already of record.

Claim Amendments

Claim 8 has been canceled without prejudice.

Independent claims 1, 19, and 21 have been amended to recite the limitation, “wherein the reflective metal layer has a thickness of at least 20 nanometers”. Support for this limitation may be found, at least, in paragraph [0038] of the application as filed.

Obviousness-Type Double Patenting Rejection

Claims 1, 4, 5, 7, 8, 10, 11, 15-19, 21, and 22 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-16 of U.S. Patent No. 7,132,149 of Borst et al. (“Borst claims”). 3/28/2007 Office Action, page 2, paragraph no. 5. Applicants respectfully traverse the rejection to the extent that it may be applicable to the claims as currently amended.

Applicants respectfully remind the Examiner that a provisional obviousness-type double patenting rejection over particular claims of the then-pending Borst claims (in U.S. Patent Application Serial No. 10/638,094) was made in the 1/11/2005 Office Action and successfully rebutted by Applicants in their 1/28/2005 Response. The arguments that Applicants made at that time continue are still applicable.

Applicants respectfully assert that the inventions of the instant rejected claims and the cited ‘094 claims are patentably distinct. The subject matter of the instant rejected claims is generally directed to reflective articles comprising, *inter alia*, an electrically non-conductive haze prevention layer. Specifically, the rejected claims each include or further limit the claim 1 limitation that “the haze-prevention layer comprises a material

having a volume resistivity of at least 1×10^{-4} ohm-centimeters measured according to ASTM D257 at 25°C.” In contrast, the subject matter of the cited ‘094 claims is generally directed to a data storage medium comprising, inter alia, a haze prevention layer with metal (i.e., an electrically conductive material). *See, e.g.*, the first listed definition of “metal” in the Merriam Webster Online Dictionary, available at <http://www.m-w.com/home.htm> (“1 : any of various opaque, fusible, ductile, and typically lustrous substances that are good conductors of electricity and heat, form cations by loss of electrons, and yield basic oxides and hydroxides; *especially* : one that is a chemical element as distinguished from an alloy” (emphasis added)). Specifically, the cited claims of the ‘094 application each include or further limit the ‘094 claim 1 limitation that “the haze-prevention layer comprises a metal . . .” Thus, the rejected claims of the instant application, which require a haze prevention layer with a non-conductive component, and the cited claims of the ‘094 application, which require a haze prevention layer with a metal which is inherently electrically conductive, are patentably distinct.

Furthermore, the Examiner is incorrect in stating that “the conflicting claims . . . are not patentably distinct from each other because the patented claims are broader in scope than the instant claims, rendering them obvious over each other.” 3/28/2007 Office Action, page 2, paragraph no. 5. This statement is incorrect for at least two reasons. First, it incorrectly suggests that the scope of the instant rejected claims represents a subset of the scope of the cited claims of the ‘094 application. Second, even if the scope of the rejected claims of the instant application were a subset of the scope of the cited claims of the ‘094 application, that would not necessarily render the rejected claims obvious over the cited claims. Otherwise, it would not be possible to patent an invention that is an improvement on an invention described in earlier, broader, dominating claims. That clearly is not the law.

Moreover, the Examiner is incorrect in stating that “[p]atented claims 1-2, 7, 13, and 16 disclose all the limitations as recited in instant independent claims 1, 19, and 21”. 3/28/2007 Office Action, page 5, first paragraph. The rejected claims each include or further limit the claim 1 limitation that “the haze-prevention layer comprises a material

having a volume resistivity of at least 1×10^4 ohm-centimeters measured according to ASTM D257 at 25°C.” This limitation is not disclosed in the cited claims of the ‘094 application.

For all of the above reasons and in view of the cancellation of claim 8, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 4, 5, 7, 10, 11, 15-19, 21, and 22 on the ground of nonstatutory obviousness-type double patenting over claims 1-16 of U.S. Patent No. 7,132,149 of Borst et al.

Finally, Applicants respectfully note that 8/11/2005 Office Action incorrectly suggested that Applicants filed a terminal disclaimer to overcome the provisional rejection of the pending Borst claims. 8/11/2005 Office Action, page 2, paragraph no. 3. Although a terminal disclaimer was filed to overcome the provisional obviousness-type double patenting rejection over U.S. Application Serial No. 10/638,145, terminal disclaimers were not filed for Serial Nos. 10/638,094 or 10/638,100.

Anticipation Rejection over Knapp

Claims 1, 4, 5, 7, 10, 11, 15-17, 19, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,846,649 to Knapp et al. (“Knapp”). 3/28/2007 Office Action, page 3, paragraph no. 7. Applicants respectfully traverse the rejection to the extent that it may be applicable to the claims as currently amended.

Knapp is generally directed to lenses and describes an abrasion-resistant dielectric composite product is described comprising a substrate and an abrasion wear resistant coating material comprising carbon, hydrogen, silicon, and oxygen and a dielectric material. Knapp abstract. In some embodiments, Knapp’s composite product comprises “a layer of semi-transparent reflective metallic material . . . inside the coating stack.” Knapp, col. 13, lines 34-36. This layer “produces a reflected color, by optical interference effects which are well known in the art.” Knapp, col. 13, lines 36-37. In order to avoid interfering with the function of the lens in which it is incorporated, “the metallic layer is typically <100 Å to allow sufficient optical transmission of the lens.” Knapp, col. 13, lines 38-39.

Applicants respectfully assert that claim 1 is not anticipated by Knapp because Knapp does not teach a reflective metal layer having a thickness of at least 20 nanometers. Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Applicants' claim 1, which is directed to a reflective article, has been currently amended to include the limitation that the reflective metal layer has a thickness of at least 20 nanometers (at least 200 Angstroms). In contrast, Knapp is directed to a type of transmissive article (a lens), and it teaches the optional semi-transparent reflective metallic layer should be thinner than 10 nanometers (less than 100 Angstroms) in order "to allow sufficient optical transmission of the lens." Knapp, col. 13, lines 39-40. Knapp thus expressly discourages metal layer thicknesses of 10 nanometers or greater. Thus, Knapp does not teach the claim 1 reflective metal layer having a thickness of at least 20 nanometers, and claim 1 is not anticipated by Knapp. Given that claims 4, 5, 7, 10, 11, 15-17, 19, 21, and 22 each expressly or inherently include or further limit all the limitations of claim 1, they too are not anticipated by Knapp. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 4, 5, 7, 10, 11, 15-17, 19, 21, and 22 under 35 U.S.C. § 102(b) over Knapp.

Obviousness Rejection over Knapp

Claims 8 and 18 stand rejected under 35 U.S.C. § 103(a) over Knapp. 3/28/2007 Office Action, page 4, paragraph no. 9. Claim 8 has been canceled without prejudice, rendering its rejection moot. Applicants respectfully traverse the rejection of claim 18.

Knapp is described above.

Applicants respectfully assert that a prima facie case of obviousness has not been established against claim 18 because Knapp does not teach or suggest a reflective metal layer having a thickness of at least 20 nanometers. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested

by the prior art. *See, e.g.*, MPEP 2143.03; *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). Claim 18 depends directly from claim 1 and therefore requires a reflective metal layer thickness of at least 20 nanometers. As discussed above, Knapp expressly discourages metal layer thicknesses of 10 nanometers or greater. Accordingly, Knapp does not teach or suggest the reflective metal layer thickness limitation of claim 18, and a *prima facie* case of obviousness against claim 18 has not been established.

Furthermore, Applicants respectfully disagree with the Examiner's statement that "it would have been obvious to one of ordinary skill in the art that the article of Knapp would have used as a headlight reflector in an automotive, which is transparent and permits viewing." 3/28/2007 Office Action, paragraph bridging pages 4 and 5.

Applicants' claim 18 is directed to an "automotive headlight reflector". To function properly, an automotive headlight reflector must be highly reflective – not transparent as the Examiner asserts. Thus, it is not at all obvious to use the lens structures of Knapp – which must be largely transparent in order to function as lenses – as automotive headlight reflectors.

For all of the above reasons, Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 18 under 35 U.S.C. § 103(a) over Knapp.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3619 maintained by Assignee.

Respectfully submitted,

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